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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

POTTER *et al.*

Appl. No. 09/808,124

Filed: March 15, 2001

For: **High Fidelity Reverse
Transcriptases and Uses Thereof**

Art Unit: 1656

Examiner: Strzelecka, T.

Atty. Docket: 0942.5030001/RWE/MTT

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Reply To Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

TECH CENTER 1600/2900

Sir:

In reply to the Office Action dated January 4, 2002, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1 (a) (in part), 2 (in part), 9 (in part), 11-22, 25-28 (all in part), 32, 47-52 (all in part), drawn to an M-MLV reverse transcriptase which has been modified or mutated to increase or enhance fidelity. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse. The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required.

The M.P.E.P. states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (Eighth Edition, Rev. August, 2001). Applicants respectfully submit that claims 1-46 (encompassed by groups I-XLI) are all drawn to reverse transcriptases and should be grouped into one group. At most, claims 1-46 may be divided into three separate groups consisting of MMLV, RSV or AMV. However the Examiner should bear in mind that these reverse transcriptase product claims encompassing any of these retroviruses are indeed related. Therefore, restricting them apart may be improper under M.P.E.P. § 803.

In addition, Groups I-XLI have been classified by the Examiner into class 435 and subclass 183, indicating that the groups are indeed related and that the burden of searching claims of groups I-XLI would not be undue. Thus, it would be a simple matter for the Examiner to search and examine publications disclosing the reverse transcriptases of claims 1-46. If the Examiner disagrees, further clarification of the current division of claims 1-46 is respectfully requested.

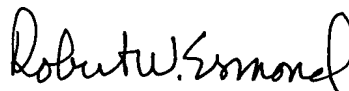
In view of the M.P.E.P. § 803 and Applicants' remarks, it is respectfully requested that claims 1-46 be searched and examined. Applicants retain the right to petition from the Restriction Requirement under 37 C.F.R. § 1.144. Reconsideration and withdrawal of the Restriction Requirement, and examination and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time

are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: Feb 22, 2002

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